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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,700	04/05/1999	YASUO NISHIDA	P17762	4029

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/12/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/285,700

Applicant(s)

NISHIDA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53,54,56-61 and 63-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53,54,56-61 and 63-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/26/03 has been entered.

Response to Amendment

2. Applicant's amendment received on 5/23/03 has been entered and made of record. Currently, **claims 53, 54, 56-61, and 63-66** are pending.

Claim Objections

3. The objections to **claims 53, 59, 60, and 66**, as cited in the Office action dated 3/28/03, are overcome by the changes set forth in the amendment dated 5/23/03.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 53, 54, 56, 57, 59-61, 63, 64, and 66** are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045) in view of Suzuki (U.S. Patent number 6,005,677, cited in the Office action dated 3/28/03).

Regarding **claim 53**, Williams discloses a communication apparatus (fax callback device 100 and 53, seen in Figs. 8-11) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (fax modem 109, column 9, lines 4 through 9, and lines 46 through 67, see Figs. 10 and 12), a communicator that performs **Internet** communication with a destination terminal via a computer network (modem 108, column 9, lines 10 through 61, see Figs. 11 and 12), a detector that detects identification information included in **a signal** which is transmitted from a facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 8, lines 53 through 60), the identification information indicating that a facsimile destination is capable of an **Internet** communication (column 8, line 55 through column 9, line 20), and a facsimile communication controller that disconnects the facsimile communication when the detector detects the identification information in **the signal** (column 8, line 61 through column 9, line 9).

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However, Williams fails to particularly teach if the Internet communication is actually an **e-mail communication**, with the identification information indicating that a facsimile destination is capable of **an electronic mail communication**. Further, Williams fails to specifically teach if the detector detects identification information included in **a non-standard signal**, and subsequently, disconnecting the facsimile communication when the detector detects the identification information in **the non-standard signal**. Suzuki discloses a communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a facsimile communicator (network controlling apparatus 10) that performs a facsimile communication with a facsimile destination via a telephone network (column 3, lines 3 through 46), an electronic mail communicator (LAN communication controlling unit 11) that performs electronic mail communication with a destination terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), and a detector (system controller 1) that detects identification information included in a non-standard signal which is transmitted from a facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 5, lines 4 through 13, and column 5, lines 53 through 59), the identification information indicating that a facsimile destination is capable of an electronic mail communication (column 10, lines 3 through 59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's teachings in the system of Williams, thereby disconnecting the facsimile communication when the detector detects the identification information in the non-standard signal. Williams' system would easily be implemented to

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include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 54*, Williams and Suzuki disclose the apparatus discussed above in claim 53, and Suzuki further teaches of a memory that is configured to store the identification associated with the facsimile destination (telephone number conversion table, seen in Fig. 3, column 3, line 63 through column 4, line 6, and column 5, lines 4 through 13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's further teachings in the system of Williams. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 56*, Williams and Suzuki disclose the apparatus discussed above in claim 53, and Williams further teaches that the communicator starts to perform the Internet communication with the facsimile destination upon disconnection of the facsimile communication (column 8, line 61 through column 9, line 37). As discussed above, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's teachings in the system of Williams, thereby modifying the Internet communication to that of an e-mail communication. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 57*, Williams and Suzuki disclose the apparatus discussed above in claim 53, and Suzuki further teaches that the non-standard signal includes capability information of the facsimile destination (column 5, lines 53 through 59, and column 9, lines 36 through 45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's further teachings in the system of Williams. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 59*, Williams discloses a communication apparatus (fax callback device 100 and 53, seen in Figs. 8-11) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (fax modem 109, column 9, lines 4 through 9, and lines 46 through 67, see Figs. 10 and 12), a communicator that performs *Internet* communication with a destination terminal via a computer network (modem 108, column 9, lines 10 through 61, see Figs. 11 and 12), an obtainer that obtains *identification information* of a facsimile destination, included in *a signal* which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 7, lines 10 through 62, and 8, line 44 through column 9, line 37), when the facsimile destination with which the facsimile communication section performs the facsimile communication, is capable of the *Internet communication* (column 8, line 55 through column 9, line 20), and a facsimile communication controller that disconnects the facsimile communication when the detector detects *the identification information in the signal* (column 8, line 61 through column 9, line 9).

However, Williams fails to particularly teach if the Internet communication is actually an *e-mail communication*, with the identification information indicating that a facsimile destination is capable of *an electronic mail communication*. Further, Williams fails to specifically teach if the obtainer obtains *an electronic mail address* of a facsimile destination,

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included in a **non-standard signal**, and subsequently, disconnecting the facsimile communication when the obtainer obtains **the electronic mail address**. Suzuki discloses a communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a facsimile communicator (network controlling apparatus 10) that performs a facsimile communication with a facsimile destination via a telephone network (column 3, lines 3 through 46), an electronic mail communicator (LAN communication controlling unit 11) that performs electronic mail communication with a destination terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), and an obtainer that obtains an electronic mail address of a facsimile destination (column 10, lines 27 through 59), included in a non-standard signal which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 5, lines 4 through 59), when the facsimile destination with which the facsimile communication section performs the facsimile communication (column 5, lines 4 through 59), is capable of the electronic mail communication (column 10, lines 3 through 59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's teachings in the system of Williams, thereby disconnecting the facsimile communication when the obtainer obtains the electronic mail address. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 60*, Williams discloses a communication apparatus (fax callback device 100 and 53, seen in Figs. 8-11) comprising a facsimile communicator that performs a facsimile

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communication with a facsimile sender via a telephone network (fax modem 109, column 9, lines 4 through 9, and lines 46 through 67, see Figs. 10 and 12), a communicator that performs **Internet** communication with a communication terminal via a computer network (modem 108, column 9, lines 10 through 61, see Figs. 11 and 12), and an adder that adds identification information to **a signal** which the facsimile communicator transmits to the facsimile sender during a facsimile protocol communication (column 8, lines 53 through 60), the identification information indicating that a communication apparatus is capable of **an Internet communication** (column 8, line 55 through column 9, line 20), detection of the identification information disconnecting a facsimile communication (column 8, line 61 through column 9, line 9).

However, Williams fails to particularly teach if the Internet communication is actually an **e-mail communication**. Further, Williams fails to specifically teach if the adder that adds identification information to **a non-standard signal** which the facsimile communicator transmits to the facsimile sender during a facsimile protocol communication, the identification information indicating that a communication apparatus is capable of **an electronic mail communication**. Suzuki discloses a communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a facsimile communicator (network controlling apparatus 10) that performs a facsimile communication with a facsimile sender via a telephone network (column 3, lines 3 through 46), an electronic mail communicator (LAN communication controlling unit 11) that performs electronic mail communication with a communication terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), and an adder (system control section 1, column 3, lines 11 through 42) that adds identification information to a non-standard signal which the facsimile

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communicator transmits to the facsimile sender during a facsimile protocol communication (column 5, lines 4 through 59), the identification information indicating that a communication apparatus is capable of an electronic mail communication (column 5, lines 4 through 59, and column 10, lines 3 through 59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's teachings in the system of Williams. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 61*, Williams discloses a method for identifying a destination terminal (see Fig. 12), with the method comprising performing a facsimile communication with a destination terminal via a telephone network (fax modem 109, column 9, lines 4 through 9, and lines 46 through 67, see Figs. 10 and 12), detecting whether identification information is included in **a signal** which is transmitted from the destination terminal while a facsimile protocol transmission is performed with the destination terminal (column 8, lines 53 through 60), the identification information indicating that the destination terminal is capable of an *Internet* communication (column 8, line 55 through column 9, line 20), storing the identification information when the identification information is detected (column 8, lines 53 through column 9, line 3, wherein the information would inherently be stored in the operation of the fax callback device), and disconnecting the facsimile communication when the detecting detects the identification information in *the signal* (column 8, line 61 through column 9, line 9).

However, Williams fails to particularly teach if the Internet communication is actually an **e-mail communication**, with the identification information indicating that a facsimile

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destination is capable of **an electronic mail communication**. Further, Williams fails to specifically teach of detecting the identification information included in **a non-standard signal**, and subsequently, disconnecting the facsimile communication when the detecting detects the identification information in **the non-standard signal**. Suzuki discloses a method for identifying a destination terminal (facsimile devices FA1 and FA2, seen in Figs. 1 and 2), with the method comprising performing a facsimile communication with a destination terminal via a telephone network (column 3, lines 3 through 46), detecting whether identification information is included in a non-standard signal which is transmitted from the destination terminal while a facsimile protocol transmission is performed with the destination terminal (column 5, lines 4 through 13, and column 5, lines 53 through 59), the identification information indicating that the destination terminal is capable of an electronic mail communication (column 10, lines 3 through 59), and storing the identification information when the identification information is detected (column 5, lines 4 through 13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's teachings in the system of Williams, thereby disconnecting the facsimile communication when the detecting detects the identification information in the non-standard signal. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 63*, Williams and Suzuki disclose the method discussed above in claim 62, and Williams further teaches of initiating an Internet communication with the facsimile destination after the facsimile communication is disconnected (column 8, line 61 through column 9, line 37). As discussed above, it would have been obvious to a person of ordinary skill in the

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art at the time the invention was made to include Suzuki's teachings in the system of Williams, thereby modifying the Internet communication to that of an e-mail communication. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 64*, Williams and Suzuki disclose the method discussed above in claim 61, and Suzuki further teaches that the non-standard signal includes capability information of the facsimile destination (column 5, lines 53 through 59, and column 9, lines 36 through 45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's further teachings in the system of Williams. Williams' system would easily be implemented to include Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

Regarding *claim 66*, Williams discloses a method (see Fig. 12) for transmitting an Internet communication function capability from a receiving terminal to a facsimile sender (column 8, line 49 through column 9, line 20), the receiving terminal having an Internet communication section that performs Internet communication with a communication terminal via a computer network (see Figs. 11 and 12), with the method comprising performing a facsimile communication with a facsimile sender via a telephone network (see Figs. 10 and 12, column 8, line 46 through column 9, line 61), and adding identification information to *a signal* included in a facsimile protocol transmission while the facsimile communication is performed with the facsimile sender (column 8, lines 53 through 60), the identification information indicating that the communication apparatus is capable of *an Internet communication* (column 8, line 55

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through column 9, line 20), detection of the identification information disconnecting a facsimile communication (column 8, line 61 through column 9, line 9).

However, Williams fails to particularly teach if the Internet communication is actually an **e-mail communication**. Further, Williams fails to specifically teach of adding identification information to a **non-standard signal** included in a facsimile protocol transmission, the identification information indicating that a communication apparatus is capable of an **electronic mail communication**. Suzuki discloses a method for transmitting an electronic mail communication function capability from a receiving terminal to a facsimile sender (facsimile devices FA1 and FA2, seen in Figs. 1 and 2), the receiving terminal having an electronic mail communication section (LAN communication controlling unit 11) that performs electronic mail communication with a communication terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), with the method comprising performing a facsimile communication with a facsimile sender via a telephone network (column 3, lines 3 through 46), and adding identification information to a non-standard signal included in a facsimile protocol transmission while the facsimile communication is performed with the facsimile sender (column 5, lines 4 through 59, and column 9, lines 36 through 56), the identification information indicating that the communication apparatus is capable of an electronic mail communication (column 5, lines 4 through 59, and column 10, lines 3 through 59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Suzuki's teachings in the system of Williams. Williams' system would easily be implemented to include

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Suzuki's teachings, as the systems share cumulative features in the art of Internet facsimile communications, being additive in nature.

6. **Claims 58 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045) in view of Suzuki (U.S. Patent Number 6,005,677, cited in the Office action dated 3/28/03), and further in view of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324, cited in the Office action dated 3/28/03).

Regarding **claims 58 and 65**, Williams and Suzuki disclose the apparatus and method discussed above in claims 57 and 64, respectively, but fail to particularly teach if the capability information includes at least resolution, print paper size, and coding system. Fite discloses a communication apparatus (fax machine 12, see Fig. 1, column 4, lines 50 through 66) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (column 4, lines 42 through 49), an electronic mail communicator that performs electronic mail communication with a destination terminal (column 4, lines 57 through 66), and a detector that detects identification information included in a non-standard signal which is transmitted from a facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 11, lines 56 through 67). Further, Fite teaches that the non-standard signal includes capability information of the facsimile destination (column 11, lines 56 through 67, and column 7, line 21 through column 8, line 34), and that the capability information includes at least resolution (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), print paper size (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), and coding

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system (column 5, line 3 through column 6, line 11, and column 7, lines 1 through 20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Williams and Suzuki. Williams and Suzuki's system would easily be modified to include the teachings of Fite, since the systems share cumulative features, being additive in nature.

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Johnson, Jr. et al. (U.S. Patent Number 6,603,569) discloses a system for transmitting a facsimile over a computer network as an e-mail.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
August 10, 2003

Ed Coles

EDWARD COLES
SUPERVISORY PATENT EXAMINER
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